

REMARKS

Claims 99-119 are pending and stand rejected.

Rejection of claims 99, 101-114 and 118 under 35 U.S.C. § 112, first paragraph:

Claims 99, 101-114 and 118 stand rejected under 35 U.S.C. § 112, first paragraph for (a) failing to comply with the written description requirement (see pp. 2-4 of Final Office Action) and (b) failing to comply with the enablement requirement (see pp. 4-8 of Final Office Action). Claims 101-114 and 118 all depend from claim 99 (claims 101-111 also depend from claim 100 in the alternative). Both rejections stem from language that was used by Applicant in describing the second element of independent claim 99, namely:

“a nucleic acid binding domain containing at least two nucleic acid binding motifs, *which do not occur together in the same protein in nature* in the same order, spacing or arrangement as is present in the chimeric transcription factor” (*emphasis added*).

The Examiner essentially argues that since all naturally occurring proteins are not yet known, a skilled person can never know for sure whether a particular grouping of nucleic acid binding motifs does or does not already occur in nature. Applicant respectfully disagrees with the Examiner for the reasons that were already presented in the Response to Office Action that was filed on March 21, 2001 (see sections I-II). Nevertheless, in order to allow this case to proceed promptly to allowance, Applicant has cancelled claims 99, 112-114 and 118 and amended claims 101-109 so that claims 101-111 depend from claim 100 only. These amendments are made without prejudice and without acquiescence to any of the Examiner's rejections. Applicant reserves the right to pursue the pending or related claims in a divisional application. In view of these amendments, the rejection under 35 U.S.C. § 112, first paragraph is moot and should be withdrawn.

Rejection of claims 99-104 and 106-119 under 35 U.S.C. § 102(e):

Claims 99-104 and 106-119 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Barbas et al. (U.S. Pat. 6,242,568). As noted in the Response that was filed April 2, 2003, Barbas et al. is not prior art to the present claims. The effective 102(e) date of Barbas et al., is December 30, 1996 (as published on the first page of U.S. Pat. 6,242,568). The present application was filed more than two years prior to this date (i.e., on December 29, 1994); the presently-pending claims are fully supported by the specification as filed and are entitled to the benefit of this filing date. Accordingly, Barbas et al. is not available as prior art.

The Examiner has argued that the effective 102(e) date that was printed on the first page of U.S. Pat. 6,242,568 is wrong and that the effective 102(e) date is in fact January 18, 1994 (see p. 10 of Final Office Action). The Examiner relies on the fact that Barbas et al. was filed as a national stage application from PCT application No. PCT/US95/00829 which claimed priority to U.S. Serial No. 08/312,604 filed September 28, 1994 and U.S. Serial No. 08/183,119 filed January 18, 1994 (both of which were subsequently abandoned).

Applicant is puzzled. Indeed, these priority filings have no bearing on the effective 102(e) date of Barbas et al. The present application was filed before November 29, 2000 and was not voluntarily published it is therefore subject to the pre-AIPA version of 35 U.S.C. § 102(e) (see MPEP § 2136), the pertinent section of which reads:

“A person shall be entitled to a patent unless (e) the invention was described in a patent granted [...] on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention by the applicant for patent.”

Nothing in the statute suggests that the effective 102(e) date is the earliest priority date of an international application. Instead, the statute explicitly states that the effective 102(e) date is the date upon which the international application fully complied with the requirements of paragraphs (1), (2), and (4) of 35 U.S.C. § 371(c). As noted on the front of U.S. Pat. 6,242,568 (Barbas et al.), this date was December 30, 1996. The rejection of claims 99-104 and 106-119 should therefore be withdrawn.

Conclusion:

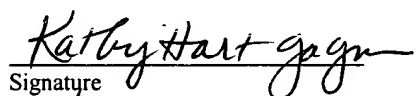
Applicant respectfully submits that the foregoing Amendments to the Claims and Remarks remove all grounds for rejection of the application, thereby placing it in condition for allowance. If it is believed that a telephone conversation would help expedite prosecution of this case, or if any further information is required, the Examiner is invited to contact the undersigned at (617) 248-5175. Additionally, please charge any fees that may be required, or credit any overpayment, to our Deposit Account No. 03-1721.

Respectfully submitted,

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